

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte JIANN H. CHEN, JOSEPH A. PAVLISKO,  
CHARLES C. ANDERSON and ROBERT A. LANCASTER

---

MAILED

MAY 27 2004

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 2003-1989  
Application 09/608,818

---

ON BRIEF

---

Before, KIMLIN, PAK and JEFFREY T. SMITH, Administrative Patent Judges.

PAK, Administrative Patent Judge.

ORDER PURSUANT TO 37 CFR § 1.196(d)

Pursuant to 37 CFR § 1.196(d)(2002), we order the appellants to clarify their election of the options provided under 37 CFR § 1.196(b)(2002).

Appeal No. 2003-1989  
Application No. 09/608,818

In our decision mailed Feb. 26, 2004 (paper 21), we affirmed the examiner's rejections of the claims on appeal under 35 U.S.C. § 103(a). (Pages 4-9.) However, we denominated our affirmance as including new grounds of rejection pursuant to 37 CFR § 1.196(b) (2002) since our decision relied on additional evidence not considered by the examiner and the appellants. (Page 9.) We then referred to the two options for further proceedings available to the appellants as provided under 37 CFR § 1.196(b), which reads in relevant part:

When the Board of Patent Appeals and Interferences makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
- (2) Request that the application be reheard under §1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . . [Emphases added.]

In response, the appellants stated that "the appellants respectfully request that their application be reheard under 37 CFR §§ 1.196(b) (2) and 1.197(b)." (Request for rehearing filed on Apr. 15, 2004, paper 22). In so doing, the appellants appear to

Appeal No. 2003-1989  
Application No. 09/608,818

indicate that they wish to exercise the second option provided in 37 CFR §§ 1.196(b) and 1.197(b) and rehear this case "upon the same record".

However, the appellants also submitted the "Chen Declaration" together with a proposal to amend to the claims on appeal. This course of action is more akin to the first option available to the appellants as provided under 37 CFR §§ 1.196(b)(1) and 1.197(a).

In view of the above inconsistencies between the appellants' statement and action, we order the appellants to clarify the option elected under 37 CFR § 1.196(b). Should the appellants elect the second option pursuant to 37 CFR §§ 1.196(b)(2) and 1.197(b), this case will be reheard based upon "the same record."

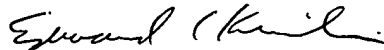


We will not consider any new proposed amendments and/or evidence, including the "Chen declaration" filed together with the Request for Rehearing dated April 15, 2004. Should the appellants elect the first option under 37 CFR §§ 1.196(b)(1) and 1.197(a), this case will be remanded to the examiner for further action consistent with 37 CFR § 1.196(b). Any new amendments and/or evidence will be entered as a matter of right so long as they are introduced before the examiner makes his or her Office action final.

Appeal No. 2003-1989  
Application No. 09/608,818

The appellant is given a non-extendable time period of ONE MONTH from the mailing date of this order to respond to our requirement. FAILURE TO RESPOND WITHIN THIS ONE-MONTH TIME PERIOD WILL RESULT IN DISMISSAL OF THE APPEAL.

ORDERED

37 CFR § 1.196(d)

  
EDWARD C. KIMLIN )  
Administrative Patent Judge )  
  
CHUNG K. PAK )  
Administrative Patent Judge )  
  
JEFFREY T. SMITH )  
Administrative Patent Judge )

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

CKP/vsh

Appeal No. 2003-1989  
Application No. 09/608,818

LAWRENCE P KESSLER  
NEXPRESS SOLUTIONS LLC  
1447 ST PAUL STREET  
ROCHESTER, NY 14653-7001